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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/716,706 11/20/00 CHAUDHARI

R U 013054-6

EXAMINER

HM22/1026

JANET I CORD
LADAS & PARRY
26 WEST 61 STREET
NEW YORK NY 10023

PRICE, E	
ART UNIT	PAPER NUMBER

1621
DATE MAILED:

7
10/26/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/716,706

Applicant(s)

CHAUDHARI ET AL.

Examiner

Elvis O. Price

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 2-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Claims 1-11 are pending in the application.

Election/Restrictions

Applicant's election of Group I in Paper No. 5 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 2-11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to non-elected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 5.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaibel et al. {CA 2260810}.

Applicants claim a hydrogenation catalyst of the general formula AB(y)C(z) wherein A is a support comprising of a salt of a Group IIA metal, B is a noble metal selected from Pd and Pt, y = 0.2 to 10%, C is nickel and z = 0 to 15% with the proviso that when B is Pt, z = 0.

Kaibel et al. teach hydrogenation catalysts that are preferably comprised of , inter-alia, nickel, Platinum and/or Palladium at 0.1 to 100% by weight, supported on various support materials including a salt of a Group IIA metal (see pg. 5, lines 5-19; lines 35-44). The difference between applicants' claimed invention and what is taught by the Kaibel et al. reference is that the Kaibel et al. reference does not specifically teach the presently claimed combination(s) of metals that make up the hydrogenation catalyst (i.e., Group II metal/Pd/Ni or Group II metal/Pt).

However, it would have been prima facie obvious to one of ordinary skill in the art to arrive at the presently claimed hydrogenation catalyst because Kaibel et al. expressly teach that, in accordance with their invention, preference is given to hydrogenation catalyst which comprise at least one element selected from six metals, wherein nickel, Platinum and Palladium are included in the said selected metals and the catalyst(s) can be supported on, inter-alia, a salt of a Group IIA metal (see pg. 5, lines 11-14 and lines 35-45).

One of ordinary skill in the art would have been motivated, in view of the Kaibel et al. teachings, to obtain the catalysts, as presently claimed, so as to use them in catalytic hydrogenation processes because nickel, Platinum and/or Palladium especially are well recognized in the art as metals used to prepare hydrogenation catalysts. Additionally, hydrogenation catalyst supports, which comprise a salt of a Group IIA metal, are well known to those of ordinary skill in the art. The instantly claimed invention would therefore be obvious to one of ordinary skill in the art.

Art Unit: 1621

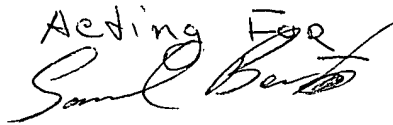
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elvis O. Price whose telephone number is 703 605-1204. The examiner can normally be reached on 8:30 am to 5:00 pm; Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 703 308-4532. The fax phone numbers for the organization where this application or proceeding is assigned is 703 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-1235.

Elvis O. Price, Ph.D.

October 23, 2001

Acting For


Johann R. Richter, Ph.D., Esq.
Supervisory Patent Examiner
Technology Center 1600